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| 09/863,910 | 05/23/2001 | Sanjay M. Kuttappa | DSCK-1158-D1 | 3334 |

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| EXAMINER |
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GORDON, RAEANN

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3711

DATE MAILED: 11/28/2005

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/863,910
Filing Date: May 23, 2001
Appellant(s): KUTTAPPA, SANJAY M.

 **MAILED**
NOV 28 2005
Group 3700

Mark D. Lorusso
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 14, 2005 appealing from the
Office action mailed January 12, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 7 - Heavy weight filler no more than 1.95% volume of the core is new matter. The table (page 7) discloses 1.95% by volume of **zirconium dioxide** present in the core and 0.48% by volume of **tungsten**; the remaining values between zero and 1.95% as claimed is new matter. The PGA compression lower 89.3 and the COR higher than 0.697.

Claim 3 - The PGA compression lower 89.3 and the COR higher than 0.697.

Claim 12 - Heavy weight filler no more than 1.95% volume of the core is new matter. The PGA compression lower than 89.3 and the COR higher than 0.697. The golf ball compression less than 97.3.

Claims 22, 23 – the golf ball compression lower than 97.3.

Claims 24, 25 – a ratio less than 15.285.

Claims 26 and 27 – zinc oxide less than 5 parts

Claim 28 - Heavy weight filler no more than 1.95% volume of the core is new matter. The PGA compression lower 89.3 and the COR higher than 0.697. The golf ball compression less than 97.3.

Claim 29 - Heavy weight filler no more than 1.95% volume of the core is new matter. The PGA compression lower 95.7 and the COR higher than 0.695. The golf ball compression less than 97.3.

(10) Response to Argument

Appellant argues the instant claims do not include new matter. The Examiner disagrees. New subject matter in the claims (added after the filing date of the application) is as follows:

Claims 1, 7 - Heavy weight filler no more than 1.95% volume of the core is new matter. The table (page 7) discloses 1.95% by volume of **zirconium dioxide** present in the core and 0.48% by volume of **tungsten**; the remaining values between zero and 1.95% as claimed is new matter. The PGA compression lower 89.3 and the COR higher than 0.697.

Claim 3 - The PGA compression lower 89.3 and the COR higher than 0.697.

Claim 12 - Heavy weight filler no more than 1.95% volume of the core is new matter. The PGA compression lower than 89.3 and the COR higher than 0.697. The golf ball compression less than 97.3.

Claims 22, 23 – the golf ball compression lower than 97.3.

Claims 24, 25 – a ratio less than 15.285.

Claims 26 and 27 – zinc oxide less than 5 parts

Claim 28 - Heavy weight filler no more than 1.95% volume of the core is new matter. The PGA compression lower 89.3 and the COR higher than 0.697. The golf ball compression less than 97.3.

Claim 29 - Heavy weight filler no more than 1.95% volume of the core is new matter. The PGA compression lower 95.7 and the COR higher than 0.695. The golf ball compression less than 97.3.

As support for the subject matter appellant refers to example 1 on page 7 of the specification. Claim 1 recites the core includes no more than 1.95% volume of heavy weight filler. However, example 1 discloses three examples with volumes 5.17% (calcium carbonate), 1.95% (zirconium dioxide), and 0.48% (tungsten). While two of the three examples fall within applicant's claimed range, the remaining values in the range from 0 to 1.95% are not disclosed. Appellant further argues page 8 of the specification

supports the claimed range. Page 8 recites, ‘...the use of heavy weight fillers results in a desirable lower PGA compression and a higher coefficient of restitution relative to a core or center made with a filler having a lower specific gravity. When a filler having a relatively low specific gravity is used, inevitably more filler has to be used to meet the desired weight range for the core or center.’ Appellant argues this portion of the specification clearly teaches to one skilled in the art that the higher specific gravity filler achieve their benefits through reduced volume. However, appellant’s arguments are not persuasive. The specification does not provide adequate support for the entire claimed range. For example, the lowest volume of filler provided in the examples is 0.48% and the specification makes an indication that lower volumes of filler is required, however; there is no guide as to the lowest possible acceptable limits that would fall within the scope of the invention. Appellants claim from 0 to 1.95% therefore would 0.001% be acceptable? One of ordinary skill in the art cannot make that determination because the specification is silent with respect to the lower limits of the claimed range. The same argument holds true for the PGA compression, coefficient of restitution (COR), the quantity of filler (claims 24, 25), and quantity of zinc oxide (claims 24 and 25). With respect to the PGA compression appellant discloses values of 95.7, 89.3, and 83.0 in example 1. Appellant later claims a range less than 89.3 or from 0 to 89.3. One of ordinary skill in the art would not assume any value from 0 to 89.3, for instance 40, would fall within the scope of the invention. With respect to the COR appellant discloses 0.695, 0.697, and 0.702. Appellant later claims a COR range higher than 0.697. As appellant is aware the larger ranges (up to 1) for a COR are very desirable in

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the golf art and one of ordinary skill in art would not assume appellants highest disclosed COR value, 0.702, would indicate values exceeding what is disclosed. With respect to the quantity of filler (claims 24, 25) appellant discloses less than 15.285. The examples on page 7 disclose specific quantities for specific fillers. Example B discloses 15.285 parts of zirconium dioxide and no other filler. One of ordinary skill in the art art would not assume that 15.285 parts of zirconium could be replaced by any filler as indicated by the claims. According to the specification, page 5, each filler has a different specific gravity, therefore, the quantity and filler types cannot be interchanged. For example, substituting a different filler in example B other than zirconium dioxide would not give the same results because the specific gravity values would be different. With respect to the quantity of zinc oxide (claims 26, 27) in the core appellant claims less than 5 part filler. The examples on page 7 each disclose 5 parts of zinc oxide in the core. One of ordinary skill in the art would not assume less than 5 parts when exactly 5 parts are disclosed for each example.

In conclusion it is submitted that the limitations as shown above are not supported by the disclosure as originally filed. Appellant is not entitled to broaden claims during prosecution by adding ranges. As shown above, the examples fall within the claimed ranges but the entire range is not supported by the discosure.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

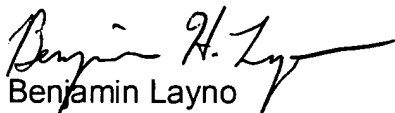


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